

## REMARKS

### I. PENDING CLAIMS

Claims 1, 17 and 19 are amended herein.

Claims 1, 16, 17 and 19 are currently pending.

### II. PRIOR ART REJECTIONS

As previously argued, claim 1 was amended to clarify that the parties involved include "a first portable telephone company", "a second portable telephone company", "a service provider of the first content", and "a service provider of the second content". In the prior art rejections, the claims are rejected over Chau as a primary reference. However, Chau does not disclose or suggest the involvement of "a first portable telephone company", "a second portable telephone company", "a service provider of the first content", and "a service provider of the second content".

In order to further clarify these distinctions, claim 1 is amended at this time to recite "a support method for transition of contents service providers providing contents about services other than communication services according to transition of portable telephone companies providing communication services different from each other." Accordingly, the content service providers are different from the portable telephone companies.

\*\*\*\*

Page 6 of the Office Action indicates that it would have been obvious to use service map files as a matter of design choice. Applicants respectfully disagree.

First, it is noted that the features of claim 1 go beyond the mere use of a service map.

Specifically, claim 1 recites "the service map file stores information of a relation of the contents group, contents including the contents group and the service providers providing the contents with the portable telephone company which can use the service providers, and the customer file stores information of the first content." Thus, there is a classifying of the contents provided by individual service companies into content groups, and only certain types of information are stored in the service map file.

Furthermore, in order to rely upon the legal theory that a design alternative does not represent a patentable distinction, the Examiner needs to provide evidence in the then-existing prior art that one of ordinary skill in the art would have been motivated to make the design alternative. As noted in MPEP 2144, "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device'" *quoting Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). To set forth a prima facie obviousness case, evidenced motivation must be provided indicating why one skilled in the art would be motivated, lead, or suggested to modify an existing reference in view of another reference. In addition, is also improper to base a rejection on the claimed feature being merely a design choice. See *In re Garrett*, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences ("Board") specifically stated: "the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none. The examiner's assertion...that the proposed modification would have been "an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art" is a conclusion, rather than a reason." Similar discussions can be seen in *In re*

*Chu*, 36 USPQ2d 1089 (Fed. Cir. 1985).

In the present case, the Examiner has not provided evidence that one of ordinary skill in the art would have been motivated to use a service map file to store the particular information as claimed.

Claims 17 and 19 include recitations which are somewhat similar to those in claim 1. Claim 16 is patentably distinguishable from *Chau* at least due to its dependence from claim 1, and *Namiki* does not overcome the deficiencies in *Chau*.

### III. CONCLUSION

In view of the above, it is respectfully submitted that the application is in condition for allowance, and a Notice of Allowance is earnestly solicited.

If any further fees are required in connection with the filing of this response, please charge the fees to our Deposit Account No. 19-3935.

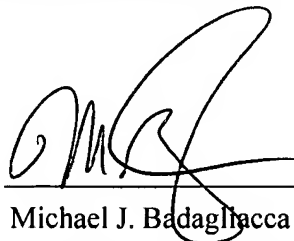
Respectfully submitted,

STAAS & HALSEY LLP

Date:

11-19-10

By:



Michael J. Badagliacca  
Registration No. 39,099

1201 New York Avenue, N.W., 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500